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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,293	07/09/2003	Kazunori Komatsu	Q76485	7080

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WASHINGTON, DC 20037

EXAMINER
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UHLIR, NIKOLAS J

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/615,293

Applicant(s)

TOGASHI, KOJI

Examiner

Nikolas J. Uhler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/09/03; 1/14/04.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida (WO98/03972).

3. US6347016 is an English equivalent to WO98/03972 and is used herein as an English translation of the WO document. All references to Ishida refer to the US document. It is noted that WO98/03972 was published on Jan 29, 1998.

4. Claim 1 requires a master information carrier having thereon a pattern of a magnetic layer representing information to be transferred to a high-density recording slave medium where the track width is not larger than 0.3 $\mu$ m, wherein the improvement comprises that the pattern is drawn by scanning a given track a plurality of times with an electron beam whose drawing diameter is smaller than the track width.

5. The limitation “wherein the improvement comprises.... smaller than the track width” is a process limitation in a product claim and does not appear to be further limiting in so far as the structure of the product is concerned. Even though product claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different

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process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP § 2113.

6. The applicant in the instant specification provides no data that establishes that a master medium produced via multiple passes of an electron beam having a write diameter that is smaller than that of the track width is structurally different from that of a master medium produced by a different process. Applicant's in their instant specification have discussed that laser ablation/lithography results in the protrusion portions of the pattern having rounded edges, whereas the method of the instant invention does not. However, magnetic masters are produced by a variety of methods other than laser ablation/lithography. Applicant has provided no data that establishes that the claimed multi pass electron beam method results in a master medium that is structurally different from a master medium that is manufactured by one of these alternative processes.

7. Bearing the above in mind, Ishida teaches a magnetic master comprising a substrate with a patterned magnetic layer on its surface. The pattern is formed in the surface of the master via lithography with a laser or an electron beam. In one embodiment, the width of the protuberance portions of the patterned magnetic layer (known to be equivalent to the track width) are  $0.2\mu$  (see figure 10). Ishida teaches that the protuberances should have a rectangular cross section, as shown in figure 3 (column 15, lines 59-67). However, Ishida teaches that if the master having protuberances width of  $0.2\mu$  is formed utilizing laser ablation/lithography, the protuberance will have curved edges, as the resolution of the developing process is insufficient (figure 10, lines 1-10). While the Ishida reference primarily focuses on the use of laser ablation/lithography

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because it is relatively inexpensive, Ishida teaches that the undesirable curved edge profile can be avoided through the use of a more advance lithographic technique.

8. From the above-cited portions of Ishida, it is clear that the Ishida reference anticipates all of the product limitations of claim 1.

9. The limitations of claims 2-4 merely further limit the process of claim 1 and do not appear to further limit the structure of the claimed product. Accordingly, these limitations are met as set forth above for claim 1.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/192849. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claim 1 of the copending application fall entirely within the scope of the instant application. The only difference between claim one of the copending application and claim one of the instant application is that the claim 1 of the copending application requires the patterned magnetic layer to

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be a soft magnetic material. Soft magnetic materials are completely encompassed by the language of claim 1 of the instant application, which requires a generic patterned magnetic layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 571-272-1517. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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